

REMARKS

Assignee respectfully requests entry of the following amendments and remarks in response to the Non-Final Office Action mailed December 9, 2009. Assignee respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1, 2, 10, 11, 18 – 20, and 25 – 27 are pending. In particular, Assignee amends claims 1, 10, 18, 19, and 25. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Assignee first wishes to express sincere appreciation for the time that Examiner Lai spent with Assignee's Attorney, Anthony Bonner, during a telephone discussion on March 2, 2010 regarding the outstanding Office Action. During that conversation, Examiners Lai and Dalencourt and Mr. Bonner discussed potential arguments and amendments with regard to claim 1, in view of *Friskel*. The general thrust of the potential principal arguments included a discussion of at least one embodiment of the present application disclosing "automatically launching an IM session with the sender." Thus, Assignee respectfully requests that Examiner Lai carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §102

A. Claim 1 is Allowable Over *Friskel*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 ("*Friskel*"). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 1 recites:

A method for initiating an instant messaging (IM) session, the method comprising:

determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account;

determining whether the sender of the received email message is a contact of a recipient of the received email message; and

in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an IM session with the sender.

(Emphasis added).

Claim 1 is allowable over *Friskel* for at least the reason that *Friskel* fails to disclose, teach, or suggest a “method for initiating an instant messaging (IM) session, the method comprising... ***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launching an IM session with the sender” as recited in claim 1. More specifically, *Friskel* discloses “[i]f status indicator 310 for such sender indicates a state in which the sender... may accept real-time messaging, for example, the states of ‘ON’ and ‘AC’, then the user can initiate real-time messaging with the sender by selecting action initiator 314” (emphasis added, column 7, line 50). As illustrated in this passage, *Friskel* discloses that real-time messaging may be initiated in response to a selection by a user. Consequently, *Friskel* cannot disclose “***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launching an IM session with the sender” as recited in claim 1. For at least this reason, claim 1 is allowable.

B. Claim 10 is Allowable Over *Friskel*

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 ("*Friskel*"). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 10 recites:

A computer-readable storage medium that includes a program that when executed by a computer performs at least the following:

determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account;

determining whether the sender of the received email message is a contact of a recipient of the received email message; and

in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an IM session with the sender.

(Emphasis added).

Claim 10 is allowable over *Friskel* for at least the reason that *Friskel* fails to disclose, teach, or suggest a "computer-readable storage medium that includes a program that when executed by a computer performs at least the following... ***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launching an IM session with the sender" as recited in claim 10. More specifically, *Friskel* discloses "[i]f status indicator 310 for such sender indicates a state in which the sender... may accept real-time messaging, for example, the states of 'ON' and 'AC', then the user can initiate real-time messaging with the sender by selecting action initiator 314" (emphasis added, column 7, line 50). As illustrated in this passage, *Friskel* discloses that real-time messaging may be initiated in response to a

selection by a user. Consequently, *Friskel* cannot disclose “***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***”, automatically launching an IM session with the sender” as recited in claim 10. For at least this reason, claim 10 is allowable.

C. Claim 18 is Allowable Over *Friskel*

The Office Action indicates that claim 18 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 (“*Friskel*”). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 18 recites:

A system for initiating an instant messaging (IM) session, the system comprising:

means for determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account;

means for determining whether the sender of the received email message is a contact of a recipient of the received email message; and

means for, ***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launching an IM session with the sender.

(Emphasis added).

Claim 18 is allowable over *Friskel* for at least the reason that *Friskel* fails to disclose, teach, or suggest a “system for initiating an instant messaging (IM) session, the system comprising... means for, ***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launching an IM session with the sender” as recited in claim 18. More

specifically, *Friskel* discloses “[i]f status indicator 310 for such sender indicates a state in which the sender... may accept real-time messaging, for example, the states of ‘ON’ and ‘AC’, then the user can initiate real-time messaging with the sender by selecting action initiator 314” (emphasis added, column 7, line 50). As illustrated in this passage, *Friskel* discloses that real-time messaging may be initiated in response to a selection by a user. Consequently, *Friskel* cannot disclose “means for, ***in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launching an IM session with the sender” as recited in claim 18. For at least this reason, claim 18 is allowable.

D. Claim 19 is Allowable Over *Friskel*

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 (“*Friskel*”). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 19 recites:

A system for initiating an instant messaging (IM) session, the system comprising:

a memory that stores at least the following:

condition-determination logic that determines whether a sender of a received email message is currently present at an Instant Messaging (IM) account;

contact determining logic that determines whether the sender of the received email message is a contact of a recipient of the received email message; and

launch logic that, ***in response to determining that the sender of the email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launches an IM session with the sender.

(Emphasis added).

Claim 19 is allowable over *Friskel* for at least the reason that *Friskel* fails to disclose, teach, or suggest a “system for initiating an instant messaging (IM) session, the system comprising... launch logic that, ***in response to determining that the sender of the email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launches an IM session with the sender” as recited in claim 19. More specifically, *Friskel* discloses “[i]f status indicator 310 for such sender indicates a state in which the sender... may accept real-time messaging, for example, the states of ‘ON’ and ‘AC’, then the user can initiate real-time messaging with the sender by selecting action initiator 314” (emphasis added, column 7, line 50). As illustrated in this passage, *Friskel* discloses that real-time messaging may be initiated in response to a selection by a user. Consequently, *Friskel* cannot disclose “launch logic that, ***in response to determining that the sender of the email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launches an IM session with the sender” as recited in claim 19. For at least this reason, claim 19 is allowable.

E. Claim 25 is Allowable Over *Friskel*

The Office Action indicates that claim 25 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 ("*Friskel*"). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 25 recites:

A system for initiating an instant messaging (IM) session, the system comprising:

a memory that stores at least the following:

condition-determination logic that determines whether a sender of a received digital message is currently present at an Instant Messaging (IM) account;

contact determining logic that determines whether the sender of the received email message is a contact of a recipient of the received email message; and

launch logic that, ***in response to determining that the sender of the received digital message is currently present at the n IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launches an IM session with the sender.

(Emphasis added).

Claim 25 is allowable over *Friskel* for at least the reason that *Friskel* fails to disclose, teach, or suggest a "system for initiating an instant messaging (IM) session, the system comprising... launch logic that, ***in response to determining that the sender of the received digital message is currently present at the n IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launches an IM session with the sender" as recited in claim 25. More specifically, *Friskel* discloses "[i]f status indicator 310 for such sender indicates a state in which the sender... may accept real-time messaging, for example, the states of 'ON' and 'AC', then the user can initiate real-time messaging with the sender by selecting action initiator 314" (emphasis added, column 7, line 50). As illustrated in this passage, *Friskel*

discloses that real-time messaging may be initiated in response to a selection by a user.

Consequently, *Friskel* cannot disclose “launch logic that, ***in response to determining that the sender of the received digital message is currently present at the n IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message***, automatically launches an IM session with the sender” as recited in claim 25. For at least this reason, claim 25 is allowable.

F. Claim 26 is Allowable Over *Friskel*

The Office Action indicates that claim 26 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 (“*Friskel*”). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 26 recites:

A computer-readable storage medium for initiating an instant messaging (IM) session, the computer-readable medium including a program that when executed by a computer performs at least the following:

determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account; and

in response to determining that the sender of the email message is currently present at the IM account, automatically, without user input, launching an IM session with the sender.

(Emphasis added).

Claim 25 is allowable over *Friskel* for at least the reason that *Friskel* fails to disclose, teach, or suggest a “computer-readable storage medium for initiating an instant messaging (IM) session, the computer-readable medium including a program that when executed by a computer performs at least the following... ***in response to determining that the sender of the email message is currently present at the IM account, automatically, without user input, launching an IM session with the sender***” as recited in claim 25. More specifically, *Friskel*

discloses “[i]f status indicator 310 for such sender indicates a state in which the sender... may accept real-time messaging, for example, the states of ‘ON’ and ‘AC’, then the user can initiate real-time messaging with the sender by selecting action initiator 314” (emphasis added, column 7, line 50). As illustrated in this passage, *Friskel* discloses that real-time messaging may be initiated in response to a selection by a user. Consequently, *Friskel* cannot disclose “***in response to determining that the sender of the email message is currently present at the IM account, automatically, without user input, launching an IM session with the sender***” as recited in claim 25. For at least this reason, claim 25 is allowable.

G. Claims 2, 11, 20, and 27 are Allowable Over *Friskel*

The Office Action indicates that claims 2, 11, 20, and 27 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 6,839,737 (“*Friskel*”). This rejection is improper for at least the reason that *Friskel* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claim 2 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 1. Dependent claim 11 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 10. Dependent claim 20 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 19. Further, dependent claim 27 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 26. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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